

PATENT APP. NO. 10/618,755
ATTY. DOCKET NO. 53394.000712
RESPONSE TO APRIL 8, 2005 OFFICE ACTION

III. REMARKS/ARGUMENTS

A. Status of the Claims

Claims 1-49 are pending in the application. Claim 33 is objected to by the Examiner. Claims 1-49 stand rejected by the Examiner. Applicants respectfully request reconsideration of the rejections of claims 1-49 for at least the following reasons.

B. Claim Objections

Claim 33 is objected for because the preamble of claim 33 recited the method of claim 1, while independent claim 1 is drawn to an article. In response, Applicants have amended claim 33 to correct its dependency.

C. Claim Rejections under 35 U.S.C. § 102(b)

Claims 1-14, 16-28, 30-32, 43-46 and 48-49 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by PCT Publication WO 99/49826 to Chmielewski ("Chmielewski"). With regard to independent claims 1 and 30, the Office Action asserts:

[a]s seen in Figures 1 and 3, [Chmielewski] discloses an absorbent article (10) comprising: a topsheet (30); a backsheet (32); and absorbent core (342) disposed between the topsheet and the backsheet; wherein the absorbent article has a thermal resistance (clo) of less than about 1.7 watts/m.sup.2, as measured in a Thermolabo apparatus.

Office Action, page 2. Applicants respectfully disagree.

In order for a claim to be anticipated by a reference, that reference must disclose each and every element of the claimed invention. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."); *see also Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) ("The identical invention must be shown in as complete detail as is contained in the . . . claim."). Referring to Figs. 1 and 3 of Chmielewski, as well as the text that accompanies these figures, there is no disclosure or suggestion regarding the

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thermal resistance (clo) of Chmielewski's absorbent article. Therefore, because Chmielewski fails to disclose every element of the claimed invention, Applicants respectfully request that the rejection of claims 1 and 30, as well as their dependent claims, be withdrawn.¹

D. Claim Rejections under 35 U.S.C. §§ 102/103

Claims 25-28 and 43-46 stand rejected under 35 U.S.C. § 102(b) as anticipated by, or, in the alternative, under 35 U.S.C. § 103(a) as allegedly rendered obvious by Chmielewski. Specifically, with regard to these claims, the Office Action asserts that Chmielewski discloses:

the absorbent article substantially as claimed. [Chmielewski] also discloses the same materials the applicant has indicated are used in the article and as the absorbent core and therefore it would be inherent that the article would provide the thermal resistance properties. In as much, the teachings of [Chmielewski] provide all that is claimed in the instant application. In the alternative it would have been obvious to have provided the material that meets the required test characteristics since applicant has not provided any most favorable product for use to provide thermal resistance or provided any proof that one of the many possible products is required to make the invention operable.

Office Action, Pages 7-8. Applicants respectfully disagree.

First, the Office Action is improperly considering claims 25-28 and 43-46 product-by-process claims. The claim language cited by the Office Action, "wherein the absorbent article has an intrinsic thermal resistance (Rcf) of less than about 0.25 °C m²/Watts, as measured on a 20 x 20 inch sample in a Thermolabo apparatus," does not

¹ If the Office Action contends that the claimed thermal resistance (clo) is inherently disclosed by Chmielewski, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990); *see also* MPEP 2112. In the present Office Action, there is no such reasoning, only the unsubstantiated assertion that Chmielewski's absorbent article "has a thermal resistance (clo) of less than about 1.7 watts/m.sup.2." Office Action, Page 2.

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indicate a process by which the claimed absorbent article is made, but rather specifies a feature or characteristic of the claimed absorbent article. In other words, the thermolabo apparatus is immaterial to the actual production of the claimed absorbent article, but is instead a tool with which the intrinsic thermal resistance (Rcf) can be measured.² Therefore, because these claims are improperly being examined under the product-by-process standard of MPEP 2113, Applicants respectfully request that this rejection be withdrawn.

Dependent claims 25, 26, 43 and 44 are directed to the intrinsic thermal resistance (Rcf) of the absorbent article, while dependent claims 27, 28, 45 and 46 provide further limitations on the thermal resistance (clo) recited in their respective independent claims. As discussed above with regard to independent claims 1 and 30, there is no disclosure in Chmielewski regarding the thermal resistance (clo) of Chmielewski's absorbent article. Nor is there any disclosure regarding the intrinsic thermal resistance (Rcf) of Chmielewski's absorbent article. Therefore, Chmielewski can only anticipate if the claimed clo and Rcf are inherently disclosed by Chmielewski.

Because the Office Action has not taken the position that independent claims 1 and 30 inherently disclose the claimed clo, it is unclear whether the Office Action contends that Chmielewski inherently discloses the claimed clo, the claimed Rcf, or both. Regardless, for either the claimed clo or Rcf to be inherently disclosed by Chmielewski, the Office Action must provide "a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990); see also MPEP 2112. All the Office Action has stated is that Chmielewski "discloses the same materials the applicant has indicated are used in the article and as the absorbent core." Office Action, Page 7. The Office Action's assertion that Chmielewski and the present invention may include

² The thermolabo apparatus is discussed on page 46, lines 8-19 of the present application.

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the same materials in their respective absorbent cores does not, however, mean that Chmielewski's absorbent core has the claimed clo and Rcf. Nor does this provide the requisite motivation to modify Chmielewski. Therefore, because Chmielewski fails to disclose or suggest all claim limitations, and there is no evidence of motivation to modify Chmielewski, Applicants respectfully request that the rejection of claims 25-28 and 43-46 be withdrawn.

E. Claim Rejections under 35 U.S.C. § 103

1. Claims 15 and 33

Claims 15 and 33 stand rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by Chmielewski in view U.S. Patent No. 5,350,370 to Jackson *et al.* ("Jackson"). Specifically, the Office Action asserts that "[Chmielewski] discloses an absorbent article comprising a topsheet, a backsheet and an absorbent core disposed between the topsheet and the backsheet." Office Action, Page 8. The Office Action admits, however, that "[Chmielewski] fails to disclose the absorbent core having a basis weight within the range of from about 650 to about 1350 gsm." *Id.* Nevertheless, the Office Action refers to Jackson, which allegedly discloses

that it is known to tailor the basis weight of an absorbent core to a specific end use typically in the range of 100-1000 grams per square meter. In particular, Jackson teaches a composite having a basis weight from 100-1000 gsm (col. 2, lines 63-64). It is well known in the diaper art to vary the basis weights, thickness and density of cores in order to accommodate the size of the intended wearer and the volume of liquid loading imparted by the intended use of the article.

Id. Thus, the Office Action contends

to form the absorbent core of [Chmielewski] having the basis weights as taught by Jackson would have been obvious to one of ordinary skill in the art at the time the invention was made in order to provide a variety of absorbent capacities for the varying needs of the wearer since the provision of size adjustability involves only routine skill in the art.

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Id. Applicants respectfully disagrees, as the Office Action has failed to establish a *prima facie* case of obviousness.

In order to establish a *prima facie* case of obviousness, at least two criteria must be met. First, there must be some motivation or suggestion to make the proposed combination or modification of the references. Further, "the teaching or suggestion to make the claimed combination must be found in the prior art, and not based on the applicant's disclosure." MPEP 2142, discussing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). In addition, the combined, or modified, references must teach or suggest all claim limitations.

The Office Action has failed to identify any teaching or suggestion to make the proposed combination *in the prior art*. Jackson only discloses a "composite having a basis weight ranging from 100 to about 1000 grams per square meter." Jackson, Col. 2, ll. 61-64. Jackson does not teach or suggest any other basis weight for its composite, and certainly not a basis weight over 1000 gsm. Moreover, there is no support for the statement that "[i]t is well known in the diaper art to vary the basis weights, thickness and density of cores in order to accommodate the size of the intended wearer and the volume of liquid loading imparted by the intended use of the article." Such a statement must be supported by evidence, either in the form of prior art or by Official Notice. See MPEP 2144.03. In the absence of such evidence, the only motivation to make the proposed combination stems from the application of impermissible hindsight, something that the Federal Circuit has repeatedly cautioned against. See *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000) ("The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art."); see also *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992); *In re Fine*,

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837 F.2d 1071 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of these claims be withdrawn.

Assuming *arguendo* that there is sufficient motivation to make the proposed combination, the combined references fail to disclose or suggest all claim limitations. As discussed above with regard to independent claims 1 and 30, there is no disclosure in Chmielewski regarding the thermal resistance (clo) of the absorbent article, nor has the Office Action asserted that the claimed thermal resistance (clo) is inherent in Chmielewski. Jackson does not cure this deficiency. Therefore, Applicants respectfully request that this rejection be withdrawn.

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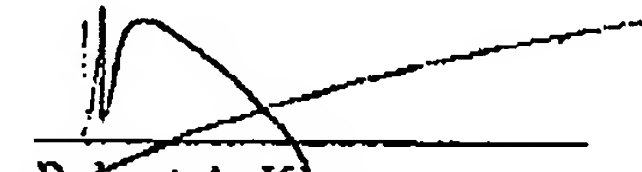
IV. CONCLUSION

Applicants respectfully submit that the application is in condition for allowance. Applicants believe that no fees are necessary in connection with the filing of this document. In the event any fees are necessary, please charge such fees, including fees for any extensions of time, to the undersigned's Deposit Account No. 50-0206. Should any outstanding issues remain, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,
HUNTON & WILLIAMS LLP

Dated: August 8, 2005

By:


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